

RE-INVENTING THE NATION'S URBAN WATER INFRASTRUCTURE [ReNUWIt]

INTELLECTUAL PROPERTY MANAGEMENT PLAN

Stanford University ("University") and its Principal Investigator, Richard G. Luthy, offer this plan addressing the management of intellectual property ("Plan") to the NSF, in accordance with its responsibilities as an NSF-funded Engineering Research Center ("ERC").

In conjunction with the NSF-funded program, the University has established an industrial membership program at the University called the "ERC Industrial Membership Program" designed to facilitate a productive relationship between the University, universities, other nonprofit organizations, municipalities, utilities, and for-profit companies participating in the ERC ("ERC Collaborators").

The ERC Collaborators recognize that intellectual property may result during the performance of the ERC award. This Plan addresses protection, licensing and dissemination of intellectual property under the ERC awards, operating within the framework established by the Bayh-Dole Act (35 U.S.C. § 200 et seq.), federal patent and copyright laws, state laws, institutional and corporate policies, and the terms of relevant grants.

The Plan objectives include:

1. To promote rapid dissemination of information in technology arising from this ERC Award;
2. To interact productively with ERC Collaborators;
3. To share unique research resources, making such resources broadly available to the research community for research purposes; and
4. To promote patenting and licensing when the public benefit is best served by commercializing inventions and/or by providing the economic rewards necessary to encourage industry to make the investment or required to move technologies to the market or to utilize the ERC technology within their business operations.

1.0 Definitions

1.1 ERC Award Work means any work or activity performed by the ERC Collaborators within the scope of agreed-upon performance and funded by the ERC award.

1.2 Background Intellectual Property means Intellectual Property developed before, or independent of, the ERC Award, whereby ERC researchers who are performing ERC Award Work are named inventors of the intellectual property, in which a license to the intellectual property is necessary in order to practice Project Intellectual Property.

- 1.3 Intellectual Property** means technical information, inventions, developments, discoveries, methods, techniques, formulae, algorithms, data, and processes, whether or not patentable or copyrightable, including computer software.
- 1.4 Tech Transfer office** means the unit within, or utilized by, an inventing organization that engages in transferring technology on behalf of inventing party.
- 1.5 Owner** refers to a party, public or private, having a legal title to Intellectual Property, as provided in the Bayh-Dole Act (35 U.S.C. 5 200 et seq.).
- 1.6 Project Intellectual Property** means and includes all Intellectual Property first conceived or developed in the performance of the ERC award.

2.0 Ownership

- 2.1** Inventorship of Project Intellectual Property will be determined in accordance with applicable U.S. patent and copyright law and any corresponding state laws.
- 2.2** Each inventing party shall determine whether to retain title pursuant to 35 U.S.C. 200 et seq. to Project Intellectual Property developed solely by employees or students of the inventing party. Project Intellectual Property developed jointly by employees and/or students of more than one party shall be jointly owned by the inventing parties; each owner will have an undivided interest in the same.
- 2.3** Each owner of Background Intellectual Property reserves all legal rights in its Background Intellectual Property for all purposes.

3.0 Oversight of Project Intellectual Property

The University, as the prime recipient of the ERC Award, will oversee implementation of this Plan and will collaborate with its Collaborators to:

- a. Monitor disclosure, patenting and licensing activity with respect to Project Intellectual Property;
- b. Seek, as needed, potential third-party licensees for Project Intellectual Property;
- c. Resolve disputes, as described in Section 4.3;
- d. Discuss, when needed, the strategy for patenting and licensing; and
- e. Facilitate timely and accurate reporting of disclosures, patents, and licenses for Project intellectual Property to the ERC Collaborators and NSF by each inventing Party, and in the final invention report of the University.

- 3.1** ERC Collaborators will make reasonable and good faith efforts to:
- a. Inform, on a periodic basis, faculty, staff and students involved in the ERC Award Work that the research is to serve the public benefit and encourage publication and prompt disclosure of developments and potential inventions.
 - b. Identify documents and share the existence of any identified Background Intellectual Property or any existing contractual agreements that may affect rights in Project Intellectual Property.
 - c. Disclose and evaluate Project Intellectual Property, Background Intellectual Property, and facilitate dissemination of the Project Intellectual Property for the greater public good.
 - d. Notify the availability of Project Intellectual Property for licensing to ERC Collaborators.
- 3.2** Data generated in the performance of the ERC Awards will be shared between Collaborators.
- 3.3** ERC Collaborators intend to encourage sharing of data and other information related to the ERC Award Work through publication, presentation or other scientific communications consistent with academic standards. ERC Collaborators performing ERC Work will be free to publish the results of the ERC Work, provided due consideration is given to protection of patentable subject matter.
- 4.0** **Reporting, Filing and Electing Title**
- 4.1** Any patent application filed relating to Project Intellectual Property will cite the support of the ERC award.
- 4.2** Each Party having sole title to Project Intellectual Property is responsible for complying with the Bayh-Dole Act, including reporting, patenting, and licensing related to the Project Intellectual Property.
- 4.3** The Parties jointly owning Project Intellectual Property are jointly responsible for compliance with the Bayh-Dole Act, including reporting, patenting and licensing activities related to the Project Intellectual Property. The Parties, through execution of appropriate Inter-Institutional or similar agreements, will jointly determine whether an application for patent or copyright will be filed on jointly owned Project Intellectual Property, which Party will prepare and file the application, the country(ies) in which the application(s) will be filed, and coverage for patent expenses. If the Parties jointly owning the Project Intellectual Property fail to execute such an agreement within 90 days of notification of their ownership interest, a Party may treat the matter as a dispute and bring it to an equitable resolution that meets the ERC award objectives.

5.0 Option to Non-Exclusive Licenses

The inventing Party shall notify the ERC Director of a Project Intellectual Property and shall offer ERC Collaborators a time-limited option to a non-exclusive license on terms to be determined. After the option period has passed, the inventing Owner may license Project Intellectual Property to non-ERC Collaborators.

6.0 Government Rights in Project Intellectual Property

Any license that an owner may grant to its Project Intellectual Property shall be subject to a reservation of rights to the Government under the provisions of 35 U.S.C. § 201 et seq.